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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 735,720	12/12/2000	Ariana L. Blum		4530

7590 07/16/2003

Blum, Ariana L.  
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[REDACTED] EXAMINER

CARIASO, ALAN B

ART UNIT	PAPER NUMBER
	2875

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/735,720	BLUM, ARIANA L.
Examiner	Art Unit	
Alan Cariaso	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 May 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 11 is/are allowed.
- 6) Claim(s) 2-4, 10, 12 and 13 is/are rejected.
- 7) Claim(s) 5-8 and 14-19 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
- 1) Certified copies of the priority documents have been received.
  - 2) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 2-4, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by ROBERTS (US 4,143,411).

3. ROBERTS discloses a flexible lighting device comprising: a flexible lighting element (10,14, figs.1-2; col.2, lines 25-26) which includes a plurality of tiny light bulbs (44) coupled to conducting wires (36,36-figs.2-3) and molded in a plastic rope (14); an adjustable shape-retaining element (80, fig.8; col.4, lines 29-38) coupled to the flexible lighting element (10) by an inherent step of coupling them; the flexible lighting device having a shape selectable at will (col.4, lines 33-38), which is changeably retained by the adjustable shape-retaining element; wherein the adjustable shape retaining element (80) is integrally formed or includes a step of integrally forming (by bonding; col.3, lines 60-63) with the flexible lighting element (10); the adjustable shape-retaining element (80) is molded in the plastic rope (col.4, lines 11-14 & 29-31).

4. As for the phrases "said flexible lighting device having a shape selectable at will, which is changeably retained by said adjustable shape-retaining element" (claim 1), "so as to form a flexible lighting device having a shape selectable at will and changeably retained by said adjustable shape-retaining element" (claim 12), any recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over LAW (US 6,352,355).

7. LAW discloses a flexible lighting device comprising: a flexible lighting element (10) which includes a plurality of tiny light bulbs (34) coupled to conducting wires (30, figs.3-4) and positioned in a fabric ribbon (10,12,14) or enclosure (28); an adjustable

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shape-retaining element (18) coupled to the flexible lighting element (10) by an inherent step of coupling them; the flexible lighting device having a shape selectable at will (col.2, lines 13-27), which is changeably retained by the adjustable shape-retaining element (col.4, lines 41-51); wherein the adjustable shape retaining element (18) is integrally formed or includes a step of integrally forming (by stitches, col.4, lines 33-40) with the flexible lighting element (10); wherein the adjustable shape-retaining element (18) is a metal wire;

8. Regarding the phrases "a plurality of tiny light bulbs molded in a plastic rope" (claim 2) and "said adjustable shape-retaining element is molded in said plastic rope" (claim 4), please note that the method of forming the device is not germane to the issue of patentability of the device itself. Even though product-by-process claims are limited by and defined by the process, determination of patentability is base on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by different process. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these process or method limitations have not been given patentable weight.

### ***Allowable Subject Matter***

9. Claims 5-8 and 14-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim 11 is allowed.

***Response to Arguments***

11. Applicant's arguments regarding claims 2-4, 12 and 13, including statements regarding amended claims 2 and 12 and the prior art to ROBERTS relied upon have been fully considered but they are not persuasive. ROBERTS still anticipate applicant's claimed structure including the addition of the light bulbs coupled to conducting wires. As for the added intended use or function a shape selectable at will, such phrases have no patentable weight if there is no difference in the claimed structure and the disclosed structure of ROBERTS. The intended use has been addressed in paragraph 4 above.

12. Applicant's arguments with respect to the rejection(s) of claim(s) 2-10 and 12-19 under CHEN have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of LAW.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. ALTMAN et al (US 6,004,004) show a plural light system that includes a flexible lighting element coupled to an adjustable shape-retaining element or wire (24) that both conducts electricity and changeably retains the shape of the flexible lighting element (col.5, lines 45-60).

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

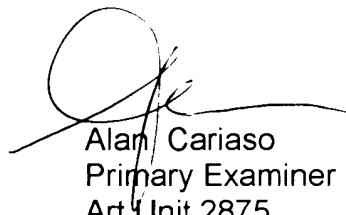
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (703) 308-1952. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Alan Cariaso  
Primary Examiner  
Art Unit 2875

AC  
July 14, 2003